

REMARKS/ARGUMENTS

Status of the Application

Prior to the entry of this amendment, claims 1-24 were pending in this application. The office action rejected the following claims: Claims 9 and 17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,275,496 to Burns et al. ("Burns") in view of U.S. Patent No. 6,714,976 to Wilson et al. ("Wilson"); claims 1-3, 8, 10, 11, 16, 18, and 24 as being unpatentable over Burns in view of Wilson and further in view of U.S. Patent No. 6,405,240 to Tsubone et al ("Tsubone"); claims 4, 5, 7, 12, 13, 15, 20, 21, and 23 as being unpatentable over Burns in view of Wilson, further in view of Tsubone and further in view of U.S. Patent No. 6,341,304 to Engbersen et al. ("Engbersen"); and claims 6, 14 and 22 as being unpatentable over Burns in view of Wilson, further in view of Tsubone and further in view of U.S. Patent No. 6,775,828 to Feinlab et al. ("Feinlab"). The present amendment adds new claims, claims 25-30. Therefore, claims 1-30 are present for examination. No new matter is added by the new claims. For instance, support for the new claims can be found at, *inter alia*, page 4, lines 18-23 and page 12, line 3 through page 17, line 26. Applicant respectfully requests reconsideration of this application as amended.

35 U.S.C. §103 Rejection, Burns in view of Wilson

The Office Action rejected independent claims 9 and 17 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of Burns in view of Wilson. Applicants respectfully traverse this rejection.

To reject claims under 35 U.S.C. §103(a), the patent office (the "Office") is charged with putting forth a *prima facie* showing of obviousness. Applicants believe a *prima facie* case of obviousness has not been properly set forth in the Office Action. The basic test is excerpted below:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.

See MPEP § 2143, Original Eighth Edition, August, 2001, Latest Revision May 2004.

Applicants believe the rejection has flaws with at least the first two prongs of the above test for establishing a *prima facie* case of obviousness. Consequently, Applicants respectfully request reconsideration of this application as amended.

1. *Motive to Combine*

The first prong of the test requires a suggestion or motivation to combine references to avoid hindsight reconstruction of the claimed invention based upon the information disclosed in the present application. If the Applicants follow the argument in the Office Action, official notice is apparently relied upon to combine these references as the motive stated in the Office Action cannot be found in either Burns or Wilson. If official notice is being proposed and maintained for the proposition that there is some type of motivation to combine Burns and Wilson, Applicants respectfully traverse this official notice and hereby request an express showing of documentary proof of this proposition as set forth in MPEP 2144.03.

Further, Applicants believe one of ordinary skill in the art would not combine Burns and Wilson in the manner suggested in the Office Action. Burns discloses an intelligent caching system for use by local service providers that, in part, addresses upstream bandwidth issues by loading content from a content server onto caches, prior to peak demand times (see Burns, col. 4, lines 29-47). Wilson discloses a method for monitoring and managing applications that are performed on distributed computer systems (see Wilson, col. 3, lines 9-33 and col. 4, lines 20-61). Wilson has absolutely nothing to do with the caching of content objects, providing

content from origin to users or addressing the upstream bandwidth issues associated with delivering content objects from origin servers to users. In fact, the combination of Burns and Wilson would produce a content server connected to a local content server caching system that is in turn connected to a distributed computing architecture consisting of work stations connected to a server(s) wherein the processing of applications on the distributed computer architecture is monitored during triggering events. Why would anyone make this combination when Wilson does not address or even recognize the problems disclosed in Burns? Accordingly, combining Burns with Wilson would not reasonably occur to one of ordinary skill in the art. The only way this combination of Burns and Wilson makes any sense is to use the Applicants' claims as a template, which is impermissible hindsight reconstruction.

With regard to Wilson, it is not clear how monitoring distributed applications would have any applicability to local service providers, including internet service providers, obtaining content objects to provide to users. Any general motivation in Wilson does not address the specific combination of elements from Wilson with the other references. In fact, although Wilson concerns computer networks, it is non-analogous art because it does not, in any respect, concern the delivery of content objects by a local service provider from a content provider to a subscriber, and, in particular, it is not concerned with upstream issues, such as loading content objects from the content provider onto caches associated with the local service provider. Additionally, Wilson is not directed to the particular problem for which the Applicants' invention is concerned. The following excerpt is quoted and explained in MPEP, Original Eighth Edition Rev. 2, May 2004, § 2141.01(a):

In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.

In re Oetiker, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Consequently, because Wilson is non-analogous art, it has nothing to do with the problems solved by the invention. Wilson relates to monitoring applications that

are processed on a distributed computer system consisting of work stations and server(s) (see Wilson, col. 3, lines 9-33). There is no contemplation in Wilson of delivery of content objects, let alone caching content objects prior to users/subscribers requesting the content objects. As such, it would not occur to one of ordinary skill in the art to even look to Wilson for any teachings relating to delivery of content objects.

2. *Reasonable Likelihood of Success in Combining Burns and Wilson*

The second prong of the test requires a reasonable likelihood of success.

Combining the pull based intelligent caching system of Burns with the system of monitoring and managing applications on a distributed computer system of Wilson is confusing to explain, at best, and requires major modifications to each reference. As discussed above, Burns concerns methods for providing content objects to subscribers and, in particular, the upstream issues of pre-loading content objects onto a local service provider's caches whereas Wilson concerns monitoring of applications processed over a distributed computer system. How would one of ordinary skill in the art hope to combine these references with any likelihood of success? The combination would produce a local content provider system where content objects are cached on the local service provider's caches connected to a distributed computer processing system that contains monitoring agents on all of its components that monitor the processing of applications on the distributed computer system. One of ordinary skill in the art would not be able to combine these references in the suggested manner with any likelihood of success.

Further, combining the content object caching system of Burns with the system of monitoring distributed applications of Wilson is not a trivial task. One of ordinary skill in the art would not be able to combine these references in the suggested manner with any likelihood of success. To say differently trivializes the substantial effort required to design and implement these types of systems.

3. *Absence of a prima facie case of obviousness*

The Office Action has rejected independent claims 9 and 17 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of Burns in view of Wilson. For reasons

set forth above, a *prima facie* case of obviousness has not been presented because no motivation to combine the references has been provided nor was there a likelihood of success in combining the cited references. Therefore, withdrawal of this rejection is respectfully requested.

35 U.S.C. §103 Rejection of Independent Claim 1 and Dependent Claims 2-8, 10-16 and 18-24

The Office Action has rejected independent claim 1 and dependent claims 2-8, 10-16 and 18-24 as being unpatentable under 35 U.S.C. §103(a). The Office Action cites three different combinations of patents for its finding that the claims are unpatentable (claims 1-3, 8, 10, 11, 16, 18, and 24 under 37 U.S.C. § 103(a) as unpatentable over Burns in view of Wilson and further in view of Tsubone et al. (U.S. Pat. No. 6,505,240); claims 4, 5, 7, 12, 13, 15, 20, 21, and 23 under 37 U.S.C. § 103(a) over Burns in view of Wilson, further in view of Tsubone as applied to claim 1 above and further in view of Engbersen et al. (U. S. Pat. No. 6,341,304); and claims 6, 14, and 22 under 37 U.S.C. § 103(a) under Burns in view of Wilson, further in view of Tsubone as applied to claim 1 above and further in view of Feinleib et al.

(U.S. Pat. No. 6,775,828)). Each of the different group of patents cited includes the combination of Burns and Wilson. Applicants respectfully submit that, for reasons set forth above, it would not be obvious to combine Burns and Wilson and, therefore, withdrawal of the rejections is respectfully requested.

Further, Applicants believe motivation for the specific combination of elements in the cited references is lacking. As best understood by Applicants, the motivation to combine arguments in the final Office Action follow a reasoning that if someone made the combination and/or substitution, the advantages would be self-evident. That is not the proper application of the test as the cited references themselves must teach or suggest the specific combination and/or substitution. To make the combination first can only be done by relying upon impermissible hindsight reconstruction using the claims as a template. Applicants also note that no cite is made to any reference for a motivation to combine, such that the Applicants can only assume Official Notice is being relied upon for this proposition. Should this apparent Official Notice be maintained, an express showing of documentary proof of the motivation is requested as set forth in MPEP 2144.03.

New Claims

Support for newly added claims 25-30 may be found, in at least page 4, lines 18-23 and page 12, line 3 through page 17, line 26. of the application. Claims 25-30 depend from independent claim 1 and are believed to be allowable for at least the same reasons discussed above. Additionally, Applicants respectfully submit that both Burns and Wilson fail to teach or suggest the additional recitations of these claims. Accordingly, Applicants respectfully submit that claims 25-30 are allowable.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


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